

**REMARKS**

With the cancellation of claims 4-18, Claims 1-3 are pending in this application. Claims 1-3 have been amended. The support for the amendments can be found at least in page 19, the last paragraph. No new matter has been introduced.

**Claim Rejections under 35 U.S.C. §112**

Applicants respectfully traverse the rejection of claim 3 under 35 U.S.C. §112, first paragraph for allegedly failing to comply with the written description requirement. The limitations reciting the third, fourth, and fifth samples were added, in the Response to Office Action filed November 10, 2008, to rephrase the definitions of  $X_0$  and  $X_{10}$  in the original claim 3. Support may be found at least in page 53, the second paragraph to page 54, the first paragraph. No new matter has been introduced. Withdrawal of the rejection is respectfully requested.

**Claim Rejections under 35 U.S.C. §103**

I. Applicants respectfully traverse the obviousness rejection of claim 1 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Arakawa et al. (US 2003/0071794).

Claim 1 has been amended to recite a heat-shrinkable polyester film comprising a lubricant in an amount of 0.02 to 0.5 mass % of the total amount of the film. Applicants have found that the addition of lubricants in a heat-shrinkable polyester film is essential for controlling the three-dimensional surface roughness  $S\Delta a$  and  $SRz$  of the film (page 18, the second paragraph to page 20, the first paragraph). Controlling of  $S\Delta a$  and  $SRz$  results in certain advantages, such as preventing the blocking of label after the heat shrinkage (page 17, the last paragraph).

None of the cited references teaches or discloses a heat-shrinkable polyester film comprising a lubricant in an amount of 0.02 to 0.5 mass % of the total amount of the film. For example, unlike the claimed invention, Arakawa does not teach or suggest including a lubricant in the film to adjust the three-dimensional surface roughness  $S\Delta a$  and  $SRz$ . Rather, Arakawa discloses a film on which “the fine irregularities” are produced by a complicated “embossing

technique” (paragraphs [0051]-[0061]). In Arakawa, the process of transferring embossing shapes onto a film includes multiple steps: first, an ultraviolet curable resin layer is provided on a transparent plastic film; then fine irregularities are provided on the ultraviolet curable resin layer by an embossing roller; and the cured resin layer is obtained by irradiating ultraviolet to the resin layer. By contrast, the claimed invention uses a simple method of adding lubricants in the specific amount as specified in claim 1 while manufacturing the film in order to control the three-dimensional surface roughness  $S\Delta a$  and  $SRz$ .

In addition, there is no motivation to combine Ito ‘437 and Ito’445 with Arakawa. The film of Arakawa is not a heat-shrinkable film. Therefore, the shapes of the fine irregularities will not be changed by further processing (such as heat shrinkage) after the fine irregularities are provided on the film. However, in a heat-shrinkable film, if the fine irregularities are provided on the film by the embossing method of Arakawa, the irregularities would become larger after the heat shrinkage, causing deterioration of the appearance of the film. Therefore, an ordinary skilled in the art would not have been motivated to modify the heat-shrinkable film of Ito ‘437 and Ito’445 by providing fine irregularities on the film using the method of Arakawa.

Even if, *arguendo*, that one of ordinary skill in the art would combine the teachings of Ito ‘437, Ito’445, and Arakawa, he still would not have arrived at the claimed invention. The purpose and method of providing irregularities on the film are different between the claimed invention and Arakawa. The present invention controls the three-dimensional surface roughness  $S\Delta a$  and  $SRz$  of the film by adding lubricants in the film so that the blocking of labels after the heat shrinkage is prevented. See page 17, the last paragraph; the paragraph bridging pages 71 and 72 of the specification. On the other hand, Arakawa discloses a film on which irregularities are provided by a embossing technique in order to prevent the film from sticking to the roll during manufacture of the film (paragraphs [0051]-[0061] and [0140]). Arakawa, as well as Ito ‘437 and Ito’445, does not teach or suggest a heat-shrinkable film comprising a lubricant in an amount of 0.02 to 0.5 mass % of the total amount of the film.

Because there would have not been motivation to combine the cited references and the references fail to teach or suggest each and every limitation of claim 1, claim 1 would not have been obvious over Ito ‘437, in view of Ito ‘445, and further in view of Arakawa. Withdrawal of the rejection is respectfully requested.

II. Applicants respectfully traverse the obviousness rejection of claim 2 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Boseki (JP 2002-331581).

Claim 2 has been amended to recite a heat-shrinkable polyester film comprising a lubricant in an amount of 0.02 to 0.5 mass % of the total amount of the film. None of Ito ‘437, Ito ‘445, and Boseki teaches or suggests this limitation. Therefore, a *prima facie* case of obviousness has not been established. Withdrawal of the rejection is respectfully requested.

III. Applicants respectfully traverse the obviousness rejection of claim 3 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Hayakawa et al. (WO 02/087853, English equivalent US 2003/0165658).

The deficiency of Ito ‘437 and Ito ‘445 is not cured by Hayakawa. Specifically, Hayaka fails to disclose a heat-shrinkable polyester film comprising a lubricant in an amount of 0.02 to 0.5 mass % of the total amount of the film, as recited in claim 3, as amended. Therefore, a *prima facie* case of obviousness has not been established. Withdrawal of the obviousness rejection of claim 3 is respectfully requested.

IV. Applicants respectfully traverse the obviousness rejections of claims 4-18 under 35 U.S.C. §103(a) over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Arakawa et al. (US 2003/0071794), as applied to claim 1, or over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Boseki (JP 2002-331581), as applied to claim 2, or over Ito et al. (US 6,458,437; “Ito ‘437”), in view of Ito et al. (US 6,451,445; “Ito ‘445”), and further in view of Hayakawa et al. (WO 02/087853, English equivalent US 2003/0165658), as applied in claim 3.

Claims 4-18 have been cancelled, rendering the rejections of these claims moot.

**CONCLUSION**

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance.

If the filing of this response is deemed not timely, Applicants petition for an appropriate extension of time.

The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,  
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